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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/766,842

01/30/2004

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EXAMINER

BARON, HENRY

ART UNIT

PAPER NUMBER

2462

NOTIFICATION DATE

DELIVERY MODE

03/17/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/766,842	Applicant(s) ABOU-CHAKRA ET AL.	
	Examiner HENRY BARON	Art Unit 2462	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13, 15-16 is/are allowed.
- 6) ☐ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

AUDIO AND VIDEO DATA PROCESSING DEVICE FOR MULTIMEDIA COMMUNICATION VIA A LOCAL NETWORK SET UP WITHIN AN ASYNCHRONOUS NETWORK

Response to Arguments/Remarks

1. Claims 1 – 13 and 15 – 16 are pending in the application.
2. An Advisory action has been sent to the Applicant citing the obvious double patenting (ODP) issue as the outstanding issue. The Applicant contacted the Examiner and explained that no action regarding the ODP could be taken until the claims were otherwise allowed.
3. In view of this, the Examiner has decided to re-open prosecution.
4. Applicant arguments of 01/24/2011 have been fully considered and were persuasive.
5. Based on Applicant's arguments, the Examiner withdraws the 35 USC § 112 rejection of claims 1 – 13 and 15 – 16 and the 35 USC § 103 rejection of claims 1 – 13 and 15 – 16.

Allowable Subject Matter

1. The Examiner finds that claims 1 – 13 and 15 – 16 are allowable and pending resolution of the double patenting issue, the application is in condition for allowance.

Obvious Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894);

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In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

9. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Application claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 7483523, hereafter ‘523. Although the conflicting claims are not identical, they are not patentably distinct from each other because application claim 1 is broader.

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11. With regards to application claim 1, '523 teaches of an Audio and video data processing device for multimedia communication, via an asynchronous network with random transmission times, between a first pair consisting of a first audio communication terminal and a first video communication terminal, a second pair consisting of a second audio communication terminal and a second video communication terminal, the said terminals being of the LAN type, where at least the first pair consists of independent and asynchronous terminals, and the processing device includes, in association with this first pair, connection means for the setting up of: ('523 claim 1 A management apparatus for managing multimedia calls set up at least via one of an asynchronous network or a traditional telephone network between a first video communications terminal associated with a first audio communications terminal and a second video communications terminal associated with a second audio communications terminal, comprising: management means for receiving a request to set up a telephone link between said first and second audio communications terminals via said traditional telephone network when the first and second video communications terminals request to set up a multimedia link to transmit at least video data via the asynchronous network.) a video link between these connection means and the video terminal of the first pair, ('523 Claim 4 read The apparatus according to claim 1, wherein said management means is arranged, on receiving the request to set up the telephone link between said first and second audio communications terminals: to order said link means to set up the telephone link between said first and second audio communications terminals to exchange audio data; and to apply to said audio data exchanged via said telephone link a transmission delay to compensate at least in part for a difference in transmission duration between said audio data exchanged via said telephone link, and the video data exchanged between said first and second video communications terminals via the multimedia link set up via said asynchronous network..)

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12. Broader application claim 1 cites an audio and video data processing device for multimedia communication but omits the '523 claim 1 citation of one of an asynchronous network or a traditional telephone network.

13. It would have been obvious at the time the invention was made by a person of to having ordinary skill in the art to modify the application claim 1 to include one of an asynchronous network or a traditional telephone network.

14. In this manner, the system could be used in an asynchronous network or a traditional telephone network.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY BARON whose telephone number is (571)270-1748. The examiner can normally be reached on 7:30 AM to 5:00 PM E.S.T. Monday to Friday.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer

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Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. B./
Examiner, Art Unit 2462

HB

/Kevin C. Harper/

Primary Examiner, Art Unit 2462